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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,812	06/26/2000	Michael Kraus	39732/DBP/E43	2076
23363	7590	01/15/2004	EXAMINER	
CHRISTIE, PARKER & HALE, LLP 350 WEST COLORADO BOULEVARD SUITE 500 PASADENA, CA 91105			EVANISKO, GEORGE ROBERT	
		ART UNIT		PAPER NUMBER
		3762		25

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/603,812	KRAUS ET AL. <i>CW</i>
Examiner	Art Unit	
George R Evanisko	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 October 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 and 10-13 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 5 and 6 is/are allowed.
- 6) Claim(s) 1-4, 7, 8 and 10-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>24</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 13, “a high-resistance or low resistance battery” is inferentially included and vague. It is unclear if the applicant intends to positively recite and claim the battery since the battery has not been positively recited. In addition, “high-resistance” and “low-resistance” are vague and are relative terms and it is unclear what the scope of a “high” or “low” resistance battery comprises.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 7, 8, and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Barreras, Sr. et al (5735887). Barreras shows capacitor 73 being used to supply energy for the reception of data and capacitor, 105, supplying energy for the transmission of data. Although capacitor 105 may not power all the transmitter circuitry, the capacitor is still an energy storage means (the claimed “power supply buffer capacitor”) that provides energy for the transmission of data. In addition, the capacitors must inherently provide sufficient energy to the

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transmitter and receiver to transmit and receive since the device would not operate if the capacitors did not provide sufficient energy.

Claims 1, 2, 4, 7, 8, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulman et al (5531774). Schulman states in column 11 the use of the receiver 200 containing diodes and energy storage capacitors to generate a DC voltage for the power supply section for the operation of the receiver. In addition, Schulman discusses the use of downconverter and capacitors, 203B, in column 25 for use in supplying power for the transmission circuit.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barreras, Sr. et al (or Schulman et al).

Barreras (or Schulman) discloses the claimed invention except for the transmitter and receiver capacitors being different sizes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the telemetry device as taught by Barreras (or Schulman), with the use of the transmitter and receiver capacitors being of different sizes since it was known in the art that transmitter and receiver capacitors are used that are different sizes to provide the different power and control requirements of the transmitter and receiver and are coordinated with the respective transmitter and receiver to send data efficiently. In addition, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the telemetry device of Barreras (or Schulman) with the use of different size transmitter and receiver capacitors, because Applicant has not disclosed that different size transmitter and receiver capacitors provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the telemetry and receiver capacitors as taught by Barreras (or Schulman) because it efficiently provides a bi-directional telemetry device. Therefore, it would have been an obvious matter of design choice to modify Barreras (or Schulman) to obtain the invention as specified in the claim(s).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schulman et al.

Schulman discloses the claimed invention and powering other implanted devices (col 34) except for the pacemaker, defibrillator, or cardioverter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the implantable transmitter and receiver as taught by Schulman, with the use of the transmitter and receiver in a pacemaker, defibrillator, or cardioverter since it was known in the art that pacemakers,

defibrillators, or cardioverters use implantable transmitters and receivers to easily power the pacemakers, defibrillators, or cardioverters and to easily transmit data.

Claims 1, 7, 8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weijand et al (5999857). Weijand shows the use of capacitors 12a and 12b to provide sufficient energy for the telemetry transmitter. In addition, he provides a power supply battery (the claimed high or low resistance battery), 66, to provide sufficient energy for the receiver and connected to the transmitter, but he does not disclose the power supply to be a buffer capacitor or powering a buffer capacitor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the receiver power supply as taught by Weijand with a buffer capacitor since it was known in the art that buffer capacitors are used as power supplies in implantable devices to provide a source of energy to power internal components, with the capacitor and supply being easily recharged from an incoming RF data signal.

***Allowable Subject Matter***

Claims 5 and 6 are allowed.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment. It is noted that the claims use the language "buffer capacitor". A buffer capacitor is a capacitor that stores and provides energy. The capacitors of Weijand, Schulman, or Barreras perform that function and are buffer capacitors. In addition, the claims use the term "power supply" buffer capacitors. All capacitors are inherently "power supply" capacitors since the definition of a capacitor is an element used to

store a charge and therefore capacitors are “power supply” capacitors. The capacitors of Weijand, Schulman, or Barreras are power supply capacitors.

It is noted that the claims use the broad terms “telemetry device”, “telemetry transmitter” and “telemetry receiver”. A telemetry device/receiver/transmitter can be any element used to transmit and receive information, from a simple antenna to a complicated system using antennas, demodulators, modulators, resistors, inductors, etc. The claims have not set forth what elements comprise a telemetry device/transmitter/receiver. In addition, the use of a simple coil and resonance capacitor for the telemetry transmitter and receiver will provide a power supply buffer capacitor powering the transmitter and/or receiver.

The argument that the references do not provide capacitors that “completely power the transmission or reception of data” is not persuasive since the claims do not contain any limitation to the capacitors “completely” powering the telemetry device/transmitter/receiver.

The argument that the examiner has acknowledged in the official action of 2/25/03, that the references do not disclose capacitors that provide “sufficient” energy for the transmitter or receiver is not persuasive because the 2/05/03 office action does not address the use of “sufficient” energy since the term was not presented until the amendment of 5/8/03. In addition, the examiner states in the office action of 7/24/03 that the references show the capacitors providing “sufficient” energy since both the receiver and transmitters receive “sufficient” energy from the capacitors in order for the telemetry device to operate correctly.

The argument that Schulman does not disclose independent capacitors for the transmitter and receiver is not persuasive since the claims do not contain any limitation to “independent capacitors”. The claims use the term “separate” capacitors and are “comprising” claims and

therefore do not preclude either capacitor from assisting the other capacitor. It is noted that applicants own claim 6 uses the transmitter capacitor to assist the receiver capacitor. In addition, Schulman teaches the use of receiver 40/200 containing energy storage capacitors to power the entire device, which includes the receiver. In addition, downconverter and capacitors, 203B, are used to supply the transmitter with power and therefore, Schulman anticipates the limitations of the claims. In addition, Barreras shows capacitor 73 supplying power for the entire system and therefore supplies power for the telemetry receiver. Barreras shows capacitor 105 supplying power to the telemetry transmitter, which is inductor 80.

The argument that the references to Duisters and Dijkmans and the EM circuit descriptions in the IDS explicitly spell out the differences between power supply buffer capacitors and resonance capacitors is not persuasive since those capacitors are only being addressed to those circuits in the references and are not directed to the claimed circuits and limitations. In addition, in response to this office action, it is requested that the applicant explicitly spell out those differences, spell out the difference between a power supply buffer capacitor and an ordinary capacitor, and the differences between the claimed functions and claimed limitations of power supply buffer capacitors and the capacitors in the references used in the rejections. In view of the claimed limitations and specification, the examiner considers a “power supply buffer capacitor” as a capacitor that provides “sufficient energy” for the telemetry receiver and transmitter (claims 1 and 13) or as any capacitor connected to the telemetry transmitter and receiver (claims 11 and 12).

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703 306-4520.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.

*luc*  
George R Evanisko  
Primary Examiner  
Art Unit 3762

GRE  
January 11, 2004

*1/11/04*